

Remarks

Claims 1 and 3-30 are pending in the present application. Claims 11-30 are withdrawn from consideration. Claims 1 and 3-10 are rejected.

Claim Rejections under 35 U.S.C. § 112, first paragraph

Claim 1 was rejected as failing to comply with the written description requirement for containing subject matter which was not described in the specification. The Applicant was said to have introduced new matter by reciting "user programmable select transistor" with no such transistor described in the original specification. Claims 3-10 were also similarly rejected for their dependence on claim 1.

To remove these rejections, claim 1 has been amended to remove reference to "user programmable" with regard to a nonvolatile memory transistor and to a select transistor.

Claim Rejections under 35 U.S.C. § 112, second paragraph

Claim 1 was rejected as being indefinite for recitation of "user programmable" in claim 1. Claims 3-10 were also similarly rejected for their dependence on claim 1.

To remove these rejections, claim 1 has been amended to remove reference to "user programmable" with regard to a nonvolatile memory transistor and to a select transistor.

Claim Rejections under 35 U.S.C. § 102(e)

Claims 1, 3-4, 6, and 9-10 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lee et al. U.S. Patent No. 6,687,154.

On page 8 of the present Office action the Examiner attempts to refute the Applicant's statement that Lee '154 does not disclose a select transistor by noting that "Lee 154 discloses two transistors memory arrays with highly

flexible design with one of the transistor fully capable of being the select transistor."

In order to anticipate a claim, a reference must teach all the elements of a claim. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631 (Fed. Cir. 1987). In addition, the reference must show the claimed invention "in as complete detail as is contained in the patent claim" in order to anticipate the claimed invention. Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Applicant asserts that the Lee et al. cited reference does not teach all of the currently claimed elements of Applicant's amended independent claim 1. Various elements of the Applicant's independent claim 1 are not disclosed in the cited Lee et al. reference.

Analysis of the Lee et al. cited reference does not show certain specific elements of Applicant's claim 1 for a transistor memory array comprising: a first plurality of non-volatile user programmable memory cells including a non-volatile memory transistor and a select transistor and a second plurality of mask programmed read-only memory cells including a mask programmed memory transistor and a select transistor, the non-volatile memory cells and the read-only memory cells having the same footprint within a single memory array.

One element missing in Lee et al. includes a first plurality of non-volatile memory cells including the claimed combination of a non-volatile memory transistor and a select transistor. Another element missing in Lee et al includes a second plurality of mask programmed read-only memory cells including the claimed combination of a mask programmed memory transistor and a select transistor.

The Examiner's argument for anticipation of the Applicant's claimed invention is that "Lee 154 discloses two transistors with highly flexibility design with one of the

transistor fully capable of being the select transistor." (underlining added) In fact, the Lee et al reference discloses that one of the transistors is a flash transistor and the other transistor is a mask ROM transistor. A so-called highly flexible design with the "capability" of being a select transistor is not a disclosure of the Applicant's claimed elements "in as complete detail as is contained in the Applicant's patent claim" per the Richardson case.

As previously mentioned, in order to anticipate a claim, a reference must teach all the elements of a claim "in as complete detail as is contained in the patent claim" in order to anticipate the claimed invention. The notion that Lee 154 discloses two transistors with highly flexibility design with one of the transistor fully capable of being the select transistor does not rise to a complete teaching of the Applicant's claimed subject matter. The Examiner appears to be bringing elements outside of the Lee et al. reference to provide complete details of the Applicant's claim. In any case, the Lee et al. reference all by itself does not teach the Applicant's claimed invention "in as complete detail as is contained in the patent claim."

In summary, the Lee et al. cited reference does not teach all the currently claimed elements of Applicant's amended independent claim 1 in as complete detail as claimed by the Applicant. Essential elements of the Applicant's independent claim 1 are not disclosed in the cited Lee et al. reference with regard to the §102(e) anticipation rejection.

Conclusion

Therefore, it is believed that claim 1 is in condition for allowance, and such action is respectfully requested. Being dependent on an allowable independent claim, the dependent claims 3-10 are also believed to be in condition for allowance and such action is also respectfully requested. The Examiner is urged to contact the Applicant's attorney if such will expedite disposition of the application.

Respectfully submitted,



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CERTIFICATE OF TRANSMISSION

UNDER 37 CFR § 1.8

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) on the date shown below.

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